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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/985,710

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Shigeru Ueda

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EXAMINER

GRANT II, JEROME

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/985,710

Applicant(s)

UEDA

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 16, 18, 21, 23-26 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 12, 14, 15, 17, 19, 20, 22 and 27 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/179,084.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-5, and 8-12 respectively of prior U.S. Patent No. 6,407,822. This is a double patenting rejection.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 13, 16, 18, 21, 23-26 and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagashima.

With respect to claim 11, Nagashima teaches an apparatus provided with a print function for printing an image specified by print data from an external apparatus 101-104 and a reading function for reading an original image (col. 5, lines 23-26), comprising: print function realizing means having a first mode (single copy mode) of realizing a print function with a smaller memory (upper or lower cassettes used) and a second mode (multiple copy mode) of realizing said print function with large memory capacity (where upper and lower cassettes are used, see col. 11, lines 27-31; discriminating means 120 according to col. 13, line 55 – col. 14, line 12 for discriminating whether the print of the image specified by the print data from the external apparatus (readers 101—104) is to be realized by the first or second mode; and control means 100 for allowing parallel execution of the printing and reading (col. 20, lines 20-32; col. 23, lines 12-17 and col. 12, lines 12-17) and in the case of the second mode not performing a parallel operation, see col. 14, lines 60-66 and col. 12, lines 22-24.

With respect to claims 13 and 18, Nagashima teaches the discrimination means 120 is adapted, based on print data from the external apparatus (readers 101-104) to judge whether said image print is to be realized by said first or second mode (single or multimode).

With respect to claim 16, Nagashima teaches a method (facilitated by RAM 142 and ROM 141 in an apparatus shown by figure 3, for controlling a printing function for printing an image specified by print data from an external apparatus 101-104 and a

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reading function for reading an original image (col. 5, lines 23-26), comprising: print function realizing means having a first mode (single copy mode) of realizing a print function with a smaller memory (upper or lower cassettes used) and a second mode (multiple copy mode) of realizing said print function with large memory capacity (where upper and lower cassettes are used, see col. 11, lines 27-31; discriminating step facilitated by means 120 according to col. 13, line 55 – col. 14, line 12 for discriminating whether the print of the image specified by the print data from the external apparatus (readers 101—104) is to be realized by the first or second mode; and control step facilitated by means 100 for allowing parallel execution of the printing and reading (col. 20, lines 20-32; col. 23, lines 12-17 and col. 12, lines 12-17) and in the case of the second mode not performing a parallel operation, see col. 14, lines 60-66 and col. 12, lines 22-24.

With respect to claim 21, Nagashima teaches an apparatus (provided in figure 3) shown with a copy function (see col. 10, lines 55-62) for printing an original image read by reader means and a printing function for printing an image specified by print data from an external apparatus 101-104, comprising: discriminating means 120 adapted, in the case of a request for copying in the course of a print job and to judge if a job is to be interrupted (data is interrupted when in the multiple mode data goes from reader to the MIMOU to the printer instead of bypassing the MIMOU. Nagashima teaches a control means 100 adapted, if the discrimination means judges that the print job is to be interrupted to resume the print operation. See col. 21, lines 30-36.

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With respect to claims 23 and 28, Nagashima teaches discriminating a job and determining if a sorting function is used. See col. 21, lines 30-47 and col. 22, lines 24-27.

With respect to claims 24 and 29, Nagashima teaches generating an image bit (from digital data taken from reading of originals) via external devices (readers 101-104) wherein the generation step is adapted if the control step interrupts the print job and executes parallel operation of the copy. See col. 21, line 65 to col. 22, line 2.

With respect to claims 25 and 30, Nagashima teaches resuming a copy operation after it has been interrupted. See col. 21, line 65- col. 22, line 2.

With respect to claim to claim 26, Nagashima teaches a method of facilitating by RAM 142 and ROM 141 controlling an apparatus (shown by figure 3), provided with a copy function performed by external apparatus 101-104 and a print function performed by printers 111-118, comprising: print function realizing means having a first mode (single copy mode) of realizing a print function with a smaller memory (upper or lower cassettes used) and a second mode (multiple copy mode) of realizing said print function with large memory capacity (where upper and lower cassettes are used, see col. 11, lines 27-31; discriminating step by means 120 according to col. 13, line 55 – col. 14, line 12 for discriminating whether the print of the image specified by the print data from the external apparatus (readers 101—104) is to be realized by the first or second mode and to judge whether the print has been interrupted by a copy status, see col. 21,

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lines 30-35 and col. 22, lines 28-35; and control means 100 for interrupting and executing a copy operation, see col. 21, lines 65 – col. 22, line 2.

3. Claims 12, 14, 15, 17, 19, 20, 22 and 27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon. -Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams, can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

J. Grant II


JEROME GRANT II
PRIMARY EXAMINER